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No. 85-2119

IN THE

Supreme Court of the United States

OCTOBER TERM, 1985

BLOCK DRUG COMPANY, INC., et al.,

Petitioners,

vs.

MILTON HODOSH and RICHARDSON-VICKS, INC.,

Respondents.

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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COUNTERSTATEMENT OF QUESTION PRESENTED

Did the Court of Appeals err by unanimously reversing the District Court's grant of summary judgment of patent invalidity for obviousness because of the existence of genuine issues of material facts?

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Hodosh v. Block Drug Co., 226 U.S.P.Q. (BNA) 645 (D.N.J. 1985)

THE CONSTITUTIONAL PROVISIONS AND STATUTES INVOLVED

35 U.S.C. §103

> Conditions for patentability; non-obvious subject matter
>
> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

F. R. Civ. P. 56(c)

> Rule 56. Summary Judgment
>
> (c) Motion and Proceedings Thereon. The motion shall be served at least 10 days before the time fixed for the hearing. The adverse party prior to the day of hearing may serve opposing affidavits. The judgment sought shall be rendered forthwith if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law. A summary judgment, interlocutory in character, may be rendered on the issue of liability alone although there is a genuine issue as to the amount of damages.

Statement Pursuant to Rule 28.1

Petitioners: Block Drug Company, Inc.
Block Drug Corporation
Dentco, Inc.

Respondents: Milton Hodosh
Richardson-Vicks, Inc.
Parent: Procter & Gamble, Inc.
Partially owned subsidiaries:
Richardson-Hindustan Limited (India)
Vick Nigeria Limited
Vidal Sassoon – MSJ (Hong Kong)
York Avenue Beauty Salons, Ltd. (Canada)
P.T. Richardson-Vicks Indonesia

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COUNTERSTATEMENT OF THE CASE

Dr. Hodosh's patent was granted, and confirmed on reexamination, for his discovery that potassium nitrate is a superior agent for the treatment of dental hypersensitivity.[1] Dr. Hodosh and Richardson-Vicks, his exclusive licensee, sued Block for infringement of that patent. Block moved for summary judgment on the

[1] Persons suffering from dental hypersensitivity react painfully to hot and cold foods, citric acid or sweets or everyday thermal or tactile stimuli, including toothbrush contact.

ground that Dr. Hodosh's patent was invalid in view of the prior art. A unanimous panel of the Court of Appeals for the Federal Circuit reversed the District Court's grant of summary judgment because of the existance of genuine issues of material fact.

The principal issues of material fact on Block's motion relate to the meaning of certain Chinese terms ("Xiao-Shi" and "Ya-Tong") and the credibility of certain Chinese references. Block's motion for summary judgment relied principally on two Chinese texts that are the work of Li-Shi-Zhen and date from the Ming Dynasty (1368-1644 A.D.). The texts are the *Grand Dictionary of Chinese Medicine* (1963) and *Ben Cao Gang Mu* (1965). The relevant portion of the *Grand Dictionary* purports to be a reprint of portions of *Ben Cao Gang Mu* and both texts contain the following passage which was translated to English and relied on by Block:

> It ["Xiao-Shi"] cures summer infection and the catching of colds. It cures acute enteritis with severe vomiting, exertion through excess sexual activity, black jaundice, chronic abdominal pain, conjunctivitis, headaches, and ["Ya-Tong"].

Block submitted affidavits of a translator and a dentist of Chinese descent to support its position that "Xiao-Shi" means potassium nitrate, and that "Ya-Tong" means toothpain including dental hypersensitivity. Belatedly, Block also submitted a statement made by Dr. Hodosh's German patent agent concerning the meaning of "Ya-Tong" to support its position. Dr. Hodosh submitted affidavits of a translator, a physician and an acclaimed expert in dentistry and the history of dentistry. The affiants supported Dr. Hodosh's position that "Xiao-Shi" does not have a definite meaning, but includes many different materials; that "Ya-Tong" does not include dental hypersensitivity; and that the

Chinese references were incredible to one skilled in this art.[2]

The District Court accepted the conflicting affidavits as evidence, yet held that there was no genuine issue of material fact, and granted Block's motion for summary judgment that the patent was obvious under 35 U.S.C. § 103.

The unanimous Court of Appeals reversed and held that the various references and affidavits presented genuine issues of material fact regarding translation, interpretation and credibility which precluded summary judgment. The Court of Appeals remanded the case for trial. Block now seeks a Writ of Certiorari to review the order of the Court of Appeals.

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[2] Even the District Court agreed with Dr. Hodosh's position that the Chinese references are "incredible and even erroneous" (App. at 64a).

The Court of Appeals noted that:

> An interesting but not atypical paragraph reads: 'For curing the paralysis of the four limbs, leprosy or problems caused by Taoist stone eating.' This substance apparently cures indigestion, lack of energy, typhoid, cataracts, and much, much more. (App. B, p. 88a.)

SUMMARY OF ARGUMENT

Block's Petition asks this Court to exercise its Certiorari jurisdiction so that this Court may weigh the competing evidence of record to determine whether material questions of fact exist in this case. This would be an inappropriate use of the Court's resources and would be contrary to the Court's policy of only granting a Writ of Certiorari in cases which involve inter-circuit conflicts or compelling questions of federal law.

Block's arguments in support of its Petition distort the record below so as to make it seem that the Court of Appeals reached its decision by ignoring Block's evidence and the teaching of the references. In truth, the Court of Appeals gave full consideration to the Chinese references of record without regard to their age and made careful note of the abundant "rebuttal evidence" introduced by Dr. Hodosh. The Court of Appeals properly remanded this case for trial "in which the conflicting views of the experts will be subject to the refining fire of cross examination" (App. at llla).

The Writ should not be granted.

REASONS WHY THE WRIT SHOULD NOT BE GRANTED

A. *This Court Should Not Exercise Its Certiorari Jurisdiction to Consider Whether, in a Particular Case, Genuine Issues of Material Fact Exist Which Preclude Summary Judgment*

Block does not question the legal principles concerning summary judgment under F.R.Civ.P. 56(c), or the tenets of patent law which were applied by the Court of Appeals. Instead, Block's Petition rests on arguments about the sufficiency, persuasiveness, or supposedly conclusive nature of the competing evidence. Reduced to its essentials, Block's Petition asks this Court to exercise its Certiorari jurisdiction solely to consider whether the record in this case establishes that Dr. Hodosh came forward with sufficient evidence to show that there are genuine issues of material fact which must be resolved at trial. Thus, the Petition is devoid of significant legal questions, much less a showing of "special and important reasons" to justify the issuance of a Writ of Certiorari (See Supreme Ct. Rule 17.1).

Not even Block contends that denial of summary judgment because of the existence of genuine issues of material fact in this case creates a conflict between Circuits on an important question of Federal law. Further, the proceedings below were entirely regular, and Block does not accuse the Court of Appeals of "depart[ing] so far from the accepted and usual course of judicial proceedings ... as to call for an exercise of this Court's power of supervision." (*id.*) Finally, it cannot be contended that the question of whether the affidavits of competing experts as to the translation, interpretation, and credibility of Chinese texts create genuine issues of fact is "an important question of federal law which has not been, but should be, settled by the Court or has [been] decided ... in a way which is in conflict with applicable decisions of this Court." (*id.*)

B. *Block's Reasons for Granting the Writ Are Based on Misstatements of the Facts and Decisions Below*

A close examination of Block's Petition reveals it to be a distorted presentation of the case.

1. There are no "unrebutted admissions" in the record. Thus, the Court of Appeals did not overlook any such "unrebutted admissions" in finding that issues of material fact exist in this case.

Block argues at pp. 17-26 of its Petition that Dr. Hodosh failed to rebut an "admission" made by his German patent agent that "Ya-Tong" means dental hypersensitivity. Block's argument ignores the abundant rebuttal affidavits submitted by Dr. Hodosh on that issue, namely the affidavit of an expert Chinese translator, the affidavit of an expert dentist and dental historian, and the affidavit of an expert physician. (See decision of Court of Appeals at App. 93a-97a).

In the face of such imposing evidence, Block can do no more than offer belated challenges to the qualifications of Dr. Hodosh's expert translator and belittle the testimony of Dr. Hodosh's expert dentist and dental historian because he is not a translator while ignoring his expert testimony as a dentist and dental historian. The record amply demonstrates that there is sufficient rebuttal affidavits in the record to create what the Court of Appeals called a "head on factual controversy." (App. at 107a).

Block seems to recognize the adequacy of Dr. Hodosh's evidence and adopts the fall-back argument that the so-called "Ya-Tong" admission is not *unrebutted* but is instead *unrebuttable*. Block never suggested in the District Court that the "admission" is unrebuttable and conceded in the Court of Appeals that it is rebuttable. (App. at 108a). The Court of Appeals held that the "admission" was *rebuttable*. (App. at 108a). Block's last-minute turnabout is without foundation in law and is a desperate attempt to avoid the weight of Dr. Hodosh's evidence by precluding its consideration.

In sum, the translation and interpretation of the term "Ya-Tong" presents genuine issues of material fact and the Court of Appeals properly remanded the case for evaluation at trial of competing expert testimony "under the refining fire of cross-examination". (App. at p. 111a).

2. Neither the District Court, the Court of Appeals nor Dr. Hodosh ever denigrated the Chinese references because they are "ancient".

Block argues that a Writ of Certiorari should be granted because the Court of Appeals failed to "give full consideration to the prior art ... by denigrating such prior art as ancient." Block's argument is a misstatement of the Court of Appeals' decision.

The Court's discussion of the teachings of the references in question (headed "The Chinese References") is found at pp. 84a to 98a of the Appendix. A careful examination of that discussion will fail to disclose a single instance where the Court of Appeals accorded the Chinese references any less weight because of their age. Moreover, Block's Petition cites not one single instance where the Court of Appeals even *hinted* that it gave diminished consideration to the Chinese references because they are ancient. Indeed, there is no indication that the District Court or the Court of Appeals cared one bit how old the references are.[3]

This is consistent with the position taken by Dr. Hodosh in his brief before the Court of Appeals at page 41:

> It is not the position of Dr. Hodosh and RVI that the Chinese references should be dismissed simply because they are old. Rather, the ancient references should be

[3] The Court of Appeals did, on occasion, characterize the Chinese references as "ancient". This was appropriate since the references are indeed quite old. For example, *Ben Cao Gang Mu* states on its face that it was "Written by: Li-Shi-Zhen in Ming Dynasty" (*i.e.*, during the period 1368 to 1644 A.D.). (App. at page 90a). These ancient references did not become young again when they were passed through a printing press and republished in 1963 and 1965.

> dismissed because they are incredible and a person of ordinary skill in the art would pay no attention to them.

Dr. Hodosh restated this position in his reply brief at page 21:

> Nor ... [has Dr. Hodosh] argued that these references are not available as prior art because they are old. The issue here is credibility, not age.

Block is the only one who ever raised the "age" of the Chinese references as an issue in this case. Apparently, Block believes that this bogus issue is useful as a red herring to distract this Court from the weakness of Block's position.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the Writ should not be granted.

Respectfully submitted

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